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### REMARKS

Claims 1-5 are pending in this application, prior to this amendment. Claims 6-20 are withdrawn from consideration as directed to a nonelected group.

Claims 1-5 were rejected on grounds of nonstatutory double patenting over U.S. Patent Nos. 6,915,430 and 6,892,302 and copending application nos. 10/248,626 and 10/248/629. Claim 1 was also rejected under 35 U.S.C. § 102(b) as being unpatentable over U.S. Patent No. 5,422,953 to *Fischer*. Claims 2-5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the *Fischer* patent in view of U.S. Patent No. 6,230,269 to *Spies*.

Claim 1 has been amended to address the § 102(a) rejection. Claims 6-20 have been cancelled. New dependent claims 21-31 are added. A Terminal Disclaimer with respect to certain patents and applications is hereby offered (see discussion below), and will be submitted upon an indication of allowability.

Reconsideration of the rejection and allowance of all claims is respectfully requested.

### *Election/Restrictions*

Claims 6-20 were withdrawn from consideration as being drawn to a nonelected group. Claims 6-20 have been cancelled.

### *Information Disclosure Statement*

The examiner indicated that the applicant had submitted an "exorbitant" amount of prior art which, on initial consideration, did not appear to have relevancy or pertinence to the invention as claimed. The examiner requested that the applicant point out which of the numerous prior art references were believed pertinent or relevant to the patentability of the invention as claimed in this application.

With all due respect, it is submitted that the submission of the information, while admittedly voluminous, should not be considered "exorbitant," it is just an inevitable result of the Applicant's development of a large volume of materials that relate to this family of patent

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applications and other related families. The materials from the various Information Disclosure Statements (IDS) were derived from those related cases and are disclosed not because any particular references are believed material, but from an abundance of caution in a good faith attempt to comply with the duty of candor and good faith towards the Patent Office. Applicant has not studied all of the materials submitted for disclosure in detail. However, the Applicant does not believe that any of the materials in the several Information Disclosure Statements are any more relevant than those which the examiner has found and cited – without admitting, of course, that even such references are sufficiently material and relevant to justify rejection of the claims at issue.

As mentioned, the various items of information cited were obtained by review of various related cases, some of which are identified on page 1 of the present application (as amended), and others from families of cases related to this case (including related continuation applications), but not necessarily studied in detail. Applicant is therefore unable to provide an explanation of why each item of art is submitted or understood to be relevant – aside from the Applicant's good faith in bringing information developed in the various related cases of record in this case, and endeavoring to direct the examiner's attention to such items as might come to the Applicant's or the undersigned's attention during prosecution of the various cases or through other means. In this regard, the examiner's attention is respectfully directed to the following items of information, all of which were cited and applied by examiners during the prosecution of certain related cases:

U.S. Patent No. 6,213,391 to *Lewis*

U.S. Patent No. 6,061,799 to *Eldridge et al.*

U.S. Patent No. 6,587,837 to *Spagna et al.*

This citation is not an admission that any of these references are any more relevant than any other references; rather, again, this information is provided out of an abundance of caution. Most of the related cases were handled by Examiner Kambiz Zand, in Art Unit 2132, who is

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very familiar with the subject matter of these families of cases and can perhaps provide additional insight as to the relevance, *vel non*, of various references cited in the IDS.

### ***Double Patenting***

Claims 1-5 were rejected on grounds of nonstatutory (obviousness-type) double patenting over U.S. Patent Nos. 6,915,430 and 6,892,302 and copending application nos. 10/248,626 and 10/248,629. The examiner asserted that independent claim 1 was met by each of the four cases, as discussed on page 3 of the Office Action.

As to the issue of obviousness-type double patenting, the examiner's attention is directed to another related patent, U.S. Patent No. 6,983,368, titled "Linking Public Key of Device to Information During Manufacture," for consideration in connection with this issue.

As recognized by the examiner, a timely filed Terminal Disclaimer generally may be used to overcome an obviousness-type double patenting a rejection for each patent and patent application that is owned by a common assignee of the present patent application and each applicable patent and patent application.

In this regard, the Applicant voluntarily agrees to submit a Terminal Disclaimer on the behalf of First Data Corporation, which is the 100% owner and common assignee of the present patent application and of the following related patents and patent applications. Specifically, the Applicant offers to submit - pending a reconsideration of one certain patent, as will be discussed below - a Terminal Disclaimer directed to at least the following patents and patent applications:

U.S. Patent Application No. 10/248,625 (now U.S. Patent No. 6,915,430)

U.S. Patent Application No. 10/248,627 (now U.S. Patent No. 6,892,302)

U.S. Patent Application No. 10/248,626

However, the obviousness-type double patenting rejection is respectfully traversed with respect to U.S. Patent Application No. 10/248,629 (now U.S. Patent No. 6,959,381) ("the '381 Patent). The '381 Patent is titled, "Central Key Authority (CKA) Database for User Accounts in

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ABDS System”, and is directed to a method of maintaining a CKA computer database by a Central Key Authority (CKA) on behalf of a plurality of users having accounts linked with one or more public keys of the users (“PuK-linked accounts”). The one or more PuK-linked accounts in this patent are maintained by one or more respective third parties. The method includes various steps, including storing in the CKA computer database a public key of a public-private key pair, the public key associated with a user device of a respective user, the user device configured to generate digital signatures using a private key of the public-private key pair, the private key maintained securely within the user device, as well as associating in the CKA computer database a security profile of the user device with the public key.

However, and significantly, the ‘381 Patent claims (e.g. see claim 1) also recites the step of associating in the CKA computer database one or more third-party account identifiers with the public key, each account identifier associated with a respective PuK-linked account of the respective user maintained by one of the respective third parties. Further, there is the step of associating a unique CKA account identifier with each public key stored in the CKA computer database. Further still, the ‘381 patent claim recites updating PuK-linked accounts of the respective user with a new public key of the respective user. Even more detailed steps are recited in the claim, relating to receiving a request “Electronic Communication,” and authenticating a message, and sending a message to various third parties, etc.

The particular method claimed in the ‘381 Patent, it is submitted, is patentably distinct, and not obvious in view of, the claimed subject matter in the present application. It is not believed that that the policies of the obviousness-type double patenting rejection are applicable in this situation because of the many different aspects and steps recited in the ‘381 Patent, and would not create any unjustified or improper timewise extension of the right to exclude granted by a patent. It is thus requested that the requirement for a Terminal Disclaimer with respect to the ‘381 Patent be reconsidered and withdrawn.

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*Claim Rejections – 35 U.S.C. § 102*

Claim 1 was rejected under 35 U.S.C. § 102(b) as being anticipated by *Fischer*, U.S. Patent No. 5,422,953. As per claim 1, the examiner took the position that applicant describes a method of manufacturing devices comprising the various limitations that were met by *Fischer*, including: a) creating a public-private key pair within the secured environment (col. 4, lines 29–34, FIG. 2); b) storing the private key within the device against the possibility of divulgement thereof by the device (col. 4, lines 29–34; col. 6, lines 10–65); and c) securely linking the public key with other information within the secure environment (col. 6, lines 10–65).

*Fischer* describes a personal date/time notary device (e.g., smart card, token, etc.) that is a secure device that digitally signs messages that include a date/time stamp. The private key is maintained within the device, which defines its own secure, tamper-resistant environment, to deter unauthorized access to, taking of, or tampering with the private key and the internal date/time clock. Trust and authenticity of the device, the private key, and the internal date/time clock is determined and reliably identified solely based upon one or more digital certificates that accompany a digital signature and time/date stamp originated by such devices. See FIG. 3, components 61, 62, of *Fischer* and related discussion. Such digital certificates include a single manufacturer's certificate 61 attesting to the fact that the device is trusted (see col. 5, ll. 60–62) and that the time-date stamp is accurate. A user's digital certificate 62 issued by a certification authority attests to the fact that the person possessing the device is the authorized user of the device.

*Fischer* contemplates that a manufacturer/certifier could issue a combined digital certificate attesting that the device is authentic and accurate and attesting to the user's identity if the user is able to present himself to the manufacturer to obtain such a certification. But where in *Fischer* is anything corresponding to a database in a secure environment in which other information is stored in association with the public key?

In the Office Action, the examiner indicated that *Fischer* provides for creating a public-private key pair “within a secured [sic] environment” and “securely linking the public key with other information within the secure environment.” There is no assertion that *Fischer* discloses a

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database for storing the public key in association with the other information. Applicant has amended claim 1 more clearly point out that the step of securely linking the public key with other information is by storing the public key in association with the other information in a database within the secure environment. As clearly seen in the dependent claim structure, the "other information" stored in the database in association with the public key can be of various types, for example, security-related information such as security features and manufacturing history of the device (claim 4), the identity of a plurality of third-parties with which an account is maintained (new claim 22), user-specific information (claim 25), etc.

Thus, the examiner's reliance upon *Fischer* to show a device having a "secure environment" is no longer applicable. There is no storage in *Fischer* of other information in association with the public key in a database in the secure environment. For this reason alone, claim 1 is not anticipated, as *Fischer* fails to disclose, teach or suggest any storage of a public key in association with other information in a database in a secure environment associated with manufacturing of the device.

Further, the Applicant points out that the claimed method is for manufacturing devices that generate digital signatures such that each device may be reliably and uniquely identified, the devices being manufactured within a secure environment. Such a secure "manufacturing" environment cannot be the a "secure environment" defined by a device itself, as suggested by the examiner's reliance on *Fischer*, because a device itself cannot define a manufacturing environment in which it itself is created. That makes no sense.

Accordingly, it is respectfully submitted that claim 1, as amended, is not anticipated by *Fischer*, and it is requested that the rejection be withdrawn.

#### ***Claim Rejections - 35 USC § 103***

Claims 2-5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Fischer* in view of *Spies*, U.S. Patent No. 6,230,269. The examiner asserted that, as per claim 2, the applicant describes the method of claim 1, which is met by *Fischer*, with the following

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limitation which is met by *Spies*: Wherein each private-public key pair is created within each device based on a random number produced by a random number generator disposed within each device (*Spies*, claim 16).

Claim 2 is a dependent claim and adds further limitations. Applicant is not claiming the use of a random number generator by itself for use in connection with the claimed method, rather, that the private key/public key pair is created within the device is based on a random number produced by a random number generator, together with the method of manufacturing steps of claim 1, which are not disclosed, taught or suggested as a whole by either *Fischer* or *Spies*. For this reason alone claim 2 should be patentable. Furthermore, under the doctrine of *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.

With respect to claim 3, the examiner asserted that applicant describes the method of claim 2, which is met by *Fischer* in view of *Spies*, with the following limitation which is met by *Fischer*: wherein each digital signature generated by each device is a random number (*Fischer*, col. 4, lines 2-7).

Claim 3 is also a dependent claim. Contrary to the examiner's assertion, *Fischer* does not show that the digital signature itself is a random number, nor does *Spies*. Rather, these references show generation of a digital signature using a random number generator. This is not the same thing as Applicant's claim that the digital signature itself is a random number. Furthermore, under the doctrine of *In re Fine*, claim 3 should be allowable on this basis as well.

As per claim 4, the examiner asserted that Applicant describes the method of claim 2, which is met by *Fischer* in view of *Spies*, with the following limitation which is met by *Fischer*: Wherein the other information comprises respective security features and a manufacturing history of each device (*Fischer*, col. 6, lines 10-65).

This is respectfully traversed. The cited portions of *Fischer* have nothing to do with security features and manufacturing history; it is not understood how the examiner can conclude that *Fischer* shows security features and manufacturing history. The cited portions related to "several ways in which the certification authority could ensure that the public key is matched

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with the private key in the secure time device.” (Col. 6, lines 22-24). This clearly requires involvement of an external certification authority. The discussion in *Fischer* relates to certificates, and a “challenge” protocol, and constructing a certificate. *Spies* provides no teachings about security features or manufacturing history. For this reason alone claim 4 is not obvious, as the applied reference is simply inapplicable. But also, the claim is allowable under *In re Fine*.

As per claim 5, the examiner asserted that the applicant describes the method of claim 2, which is met by *Fischer* in view of *Spies*, with the following limitation which is met by *Fischer*: identifying a particular manufactured device by authenticating a message using one of said linked public keys, a digital signature for the message having been generated by the particular manufactured device (*Fischer*, col. 7, lines 20-34).

The cited portion of *Fischer* does not meet the claim, as amended. Claim 5 has been amended to recite the step of identifying a particular manufactured device by authenticating a message using one of a plurality of public keys in the database within the secure environment, a digital signature for the message having been generated by the particular manufactured device. Col. 7, lines 20-34 of *Fischer* relate to verifying a signature by any entity having the public key – without any disclosure or teaching of how that public key came to be obtained and used. This contrasts with claim 5’s recitation that the public key used for identifying is from the database in the secure environment. For this reason alone claim 5 is not obvious and should be allowable. However, claim 5 is also allowable under *In re Fine*.

For the foregoing reasons, it is submitted that the rejection of claims 2-5 should be withdrawn.

New dependent claims 21-31 are presented for entry. Such new claims raise no issues not previously considered by the examiner, are fully supported by the specification, and should be allowable. It is noted that such new claims, for the most part, are derived from the dependent claim set that accompanied withdrawn claim 6, except of course adapted to be dependent under the remaining method claim 1 in this case. Favorable consideration and allowance of these dependent claims is respectfully submitted.

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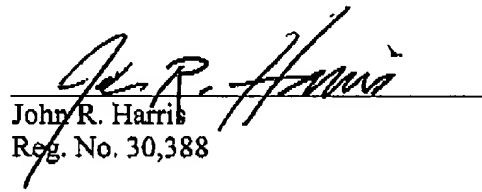
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*Conclusion*

For the foregoing reasons, it is submitted that all claims are believed novel, nonobvious, fully supported, and should be allowable. The foregoing is submitted as a full and complete response to the Office Action mailed September 7, 2005 and is believed to place all claims in the application in condition for allowance. Accordingly, it is respectfully submitted that this application be allowed and that a Notice of Allowance be issued. If the Examiner believes that a telephone conference with the Applicant's attorneys would be advantageous to the disposition of this case then the Examiner is encouraged to telephone the undersigned at 404 504 7720.

Respectfully submitted,

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